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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/709,081	04/12/2004	Craig M. Sanborn	SANBP001US	1695
27949	7590	07/18/2006	EXAMINER	
LAW OFFICE OF JAY R. YABLON 910 NORTHUMBERLAND DRIVE SCHEECTADY, NY 12309-2814			BERGIN, JAMES S	
		ART UNIT	PAPER NUMBER	
		3641		

DATE MAILED: 07/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/709,081	SANBORN, CRAIG M.	
	<b>Examiner</b>	<b>Art Unit</b>	
	James S. Bergin	3641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 4/26/2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-107 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) \_\_\_\_\_ is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) 1-107 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

***Election/Restrictions***

1. The following revised restriction requirement is provided in response to the applicant's traversal (filed 4/26/2006) of the previous restriction (mailed 3/29/2006).
2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-87, drawn to a projectile and components therefor, classified in class 102, subclass 510.
  - II. Claims 88-91, 93, drawn to a method of making a projectile and components therefor, classified in class 86, subclass 1.1.
  - III. Claims 92, 94-97, drawn to a method of loading a firearm, classified in class 89, subclass 45.
  - IV. Claims 98-100, drawn to a method of firing a projectile at a target, classified in class 89, subclass 1.11.
  - V. Claim 101-107, drawn to a method of producing varying weight bullets, classified in class 86, subclass 54.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the projectile or components of the projectile as claimed in the independent claims of invention I could either be made without all of the method steps of independent method claim 88 or by a method performing the steps

of claim 88 in a different order. For instance, independent claim 1 does not require the specific pressure shield sub-assembly of the method claim 88. Similarly, independent claim 28 does not require the specific expansion tip sub-assembly of method claim 88. An example of a method with steps performed in a different order would be a method in which the expansion tip is inserted into the front of the hollow core before the insertion of the pressure shield mating extension is inserted into the hollow core.

4. Inventions II and III are directed to related methods. The related inventions are distinct if the inventions as claimed do not overlap in scope, i.e., are mutually exclusive; the inventions as claimed are not obvious variants; and the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect. See MPEP § 806.05(j). In the instant case, the method of loading a firearm does not include loading a projectile with all the claimed features of the projectile produced by method claim 88 and the projectile produced by the method of claim 88 could be loaded into a breech-loading gun.

5. Inventions III and IV are directed to related methods. The related inventions are distinct if the inventions as claimed do not overlap in scope, i.e., are mutually exclusive; the inventions as claimed are not obvious variants; and the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect. See MPEP § 806.05(j). In the instant case, the method of loading a firearm does include loading a projectile with all the claimed features the fired projectile of independent method claim 98.

6. Inventions IV and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the method of firing a bullet at a target (invention IV) does not involve producing a plurality of varying weight bullets of a given caliber.

7. Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the projectile of invention 1 could conceivably be loaded into a breech loading gun rather than a muzzle-loading gun.

8. Inventions I and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the projectile of invention 1 could conceivably be fired from a breech loading gun rather than a muzzle-loading gun.

9. Inventions II and IV are directed to related methods. The related inventions are distinct if the inventions as claimed do not overlap in scope, i.e., are mutually exclusive; the inventions as claimed are not obvious variants; and the inventions as claimed are

either not capable of use together or can have a materially different design, mode of operation, function, or effect. See MPEP § 806.05(j). In the instant case, the projectile produced by the method of invention II could be fired from a breech-loading gun.

10. Inventions II and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the method of invention II does not involve producing a plurality of varying weight bullets of a given caliber.

11. Inventions I and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the method of group IV could be performed by a bullet having an expansion-inducing tip that is non-integral with the core material in the hollow of the bullet.

12. Inventions V and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the projectile assembly of group I can be made by a process that does not involve the step of making a first bullet and a second bullet, the first and second bullets having different weights from one another.

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13. Because these inventions are independent or distinct for the reasons given above, because the inventions also require a different field of search and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

#### **ELECTION OF SPECIES**

14. This application contains claims directed to the following patentably distinct species:

Species A, the embodiments depicted in Figs. 1-6 and 8-10

Species B, the embodiments depicted in Fig. 7, 17 and 18

Species C, the embodiment depicted in Fig. 19

The applicants are also asked to choose between the following sub-species:

Sub-species a, pressure shield embodiment depicted in Fig. 13

Sub-species b, pressure shield embodiment depicted in Fig. 14

Sub-species c, pressure shield embodiment depicted in Fig. 15

Sub-species d, pressure shield embodiment depicted in Fig. 16

15. The species are independent or distinct because they define patentably distinct alternative species and sub-species of the invention. Searching and examining all the species and sub-species would be excessively burdensome as it would require different

fields of search in the form of different search queries for each species and sub-species. Thus restriction between the species and sub-species is proper in this instance.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim has been identified as generic to all species and sub-species.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

16. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species, sub-species and invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103 (a) of the other invention.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James S. Bergin whose telephone number is 571-272-6872. The examiner can normally be reached on Monday - Wednesday and Friday, 8.30 - 5.30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on 571-272-6873. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



James S. Bergin